

DISCUSSION OF THE AMENDMENTS

Claims 1, 4, 14, 15 and 36 are currently amended.

Claims 2, 3, 6, 8, 10, 12, 16-21 and 37-41 are original.

Claims 5, 7, 9, 11, 13, 22-35 and 42-54 are cancelled without prejudice or disclaimer.

Claims 55 is new.

Upon entry of the amendments claims 1-4, 6, 8, 10, 12, 14-21, 37-41 and 55 will be active.

The amendments to claim 1 are supported by claim 1 as originally filed and by the species disclosed in the specification where T is a bond (e.g. see original claim 5).

The amendment to claim 14 is supported by the claim as originally filed.

The amendments to claim 36 are supported by the specification on page 58-72 of the specification.

New claim 55 is supported on pages 69 and 70 of the specification.

No new matter has been added.

REMARKS

Applicants would like to thank Examiner Tucker for the careful and detailed examination of the application. In addition, Applicants would like to thank Examiner Tucker for indicating the allowable subject matter as outlined on pages 23 and 24 of the Office Action.

Claims 1-53 were rejected under 35 U.S.C. §112, second paragraph as outlined on pages 4-6 of the Office Action. As the Examiner will note the claims have been amended such that they are free of the criticisms outlined on pages 4 and 5 of the Office Action. Specifically, T has been amended to include a bond as supported by the compounds given in original claims 9 and 10. Applicants note that claim 14 q is 1 and so T is present as given in claim 14. In addition, claim 14 has been amended to clarify claim language as noted by the Examiner.

With regard to the rejection of the term “For inhibiting PARP activity” in claim 36, Applicants submit that this term is adequately described in the specification in the Background of the Invention, and therefore, Applicants are entitled to claim the genus PARP without claiming PARP species. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection over this term.

Claims 1-53 were rejected under 35 U.S.C. §112, first paragraph over the recitation “prodrugs”. Applicants note that the claims are free of this criticism, and therefore, Applicants respectfully request that the Examiner withdraw this rejection.

Claims 22-53 were rejected under 35 U.S.C. §112, first paragraph for lack of enablement regarding several recited treatment methods. Applicants note that claims 36-41 satisfy 35 U.S.C. §112, first paragraph, and therefore, the rejection should be withdrawn. Specifically, a method for inhibiting PARP activity is demonstrated on pages 58-64 of the specification. A method for treating neural tissue damage is demonstrated on 64-70 of the specification.

Claim 14 was rejected under U.S.C. §102(b) over Sieqlitz et al. (“3-hydroxyfluoro-anthene-1,-2-, and 10-carboxylic acids” *Chemische Berichte*, Vol. 95, pages 3013-3029 (1962) as abstracted by Caplus). Applicants note that claim 14 has been amended to recite that q is one.

Accordingly, Sieqlitz does not teach or suggest the claimed compound, and therefore, Applicants respectfully request that the Examiner withdraw the rejection.

Claims 1-6, 8, 10, 12, 14 and 15 were rejected on the grounds of nonstatutory obviousness-typed double patenting over claims 1-9, 11 and 12 of U.S. Patent 6,716,828. Claims 16-21 were rejected on the grounds of nonstatutory obvious-type double patenting over claims 13-18 of U.S. Patent 6,716,828. Claims 1, 9 and 14 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-3 of U.S. Patent 6,291,425.

The rejection of the claims on the grounds of nonstatutory obviousness-type double patenting is obviated by the enclosed Terminal Disclaimer. In view of the disclaimer, Applicants request that the Examiner withdraw the rejection. The filing of a terminal disclaimer is not to be construed as an admission, estoppel or acquiescence.

Claim 13 was rejected under 35 U.S.C. §101 over claim 10 of U.S. Patent 6,716,828 and claim 7 was rejected over claim 1 of U.S. Patent 6,291,425. The rejections have been obviated by amendment. Therefore, Applicants request that the rejections be withdrawn.

Objections to claims 22-35 have been obviated by amendment.

The objection to the Abstract has been obviated by amendment.

Applicants respectfully request that the Examiner provide Applicants with an initialed copy of the IDS filed with the application on February 6, 2004.

In light of the above remarks, Applicants submit the application is in condition for allowance. Favorable reconsideration is respectfully requested.

Applicants have included fees for a Terminal Disclaimer with this response and believe no additional fees are due with this response. However, if any additional fees are due, please charge our Deposit Account No. 22-0185, under Order No. 22227-00005-US1 from which the undersigned is authorized to draw.

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Respectfully submitted,
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